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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,555

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George Miller

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25/006

7590

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EXAMINER

PATEL, BHARAT C

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

01/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,555

**Applicant(s)**

MILLER, GEORGE

**Examiner**

BHARAT C. PATEL

**Art Unit**

3724

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-20 and 24-51 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 6-12, 14-16, 24-30, 33 and 36-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 13, 18-23, 30-32, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following is a Final Office action in response to communication received on 11/14/08. Claims 13, 21-23 and 52-66 are cancelled. Claims 3-4, 6-12, 14-18, 24-30, 33 and 36-51 are withdrawn. Claims 1 and 35 are amended. Therefore, claims 1-2, 5, 19, 31-32 and 34-35 are pending and addressed below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5, 19, 31, 32, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang 6,308,421.

Re claim 1, Wang discloses a body 11, cutting means 1, 2, comprising first 53 and second 31 portions supported by the body 11, said second portion 31 being pivotally mounted (per col. 2, lines 42-43) relative to the first portion 53 and moveable along an arcuate path towards the first portion 53 as per Fig. 1, each portion comprising at least one cutting edge which in use cooperate to produce a shearing strain in a material positioned therebetween and adapted for cutting a portion of material from the cast by a shearing action; and a protection member 55 supported by the body 5 and adapted to be positioned between the cast portion operated upon by cutting means, 1 and 2 per Fig. 1, and the patient, to protect the skin of the patient, wherein the cutting means is adapted to cut material by a shearing action by the interaction of first 53 and

second 31 portions. It should be noted that the body 5 provides extension of the first portion and also for the protection member per Fig. 1. It should be noted that a protection member taught by Wang is fully capable of being adapted so that it can safely and operationally being held between the skin of the patient and the cast material.

Re claim 2, Wang discloses that the cutting means 1, 2, is adapted for removing a strip of material from the cast.

Re claim 5, Wang discloses that the protection member 55 is releasably coupled to the body 11 per Fig. 1.

Re claim 19, Wang discloses that the first portion 53 is located on the protection member 55 per figs. 1 and 2.

Re claim 31, Wang discloses that a leading edge of the second portion 31 of the cutting means is chamfered per Fig. 1. It should be noted that Wang shows the chamfer at the leading edge, in longitudinal direction of the second portion, and also along the thickness portion of the same portion per Fig. 1.

Re claim 32, Wang discloses that the first portion 53 defines an aperture which is chamfered at one side per Figs. 1 & 2. It should be noted the aperture is an opening or gap as defined (by [www.dictionary.com](http://www.dictionary.com)) per attached document for reference.

Re claim 34, Wang discloses that the cutting means 1, 2, is adapted to remove continuous strips of material from a cast and the first portion 53 of the cutting means 1, 2, comprises a strip exit, as Right Hand side portion of the 53 per Fig. 1, to allow a strip of the cast which is being removed to pass therethrough.

Re claim 35, Wang discloses that the strip exit, as Right Hand side portion of the 53, comprises tapered sides, which taper outwards towards Right Hand side per Fig. 1, away from the aperture of the first portion 53.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang 6,308,421.

Wang teaches the invention as claimed as discussed above. However, Wang fails to teach that the first portion is mounted separately from the protecting member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to separately mount the protection member to the first portion, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

***Response to Arguments***

6. Applicant's arguments filed on 11/14/08 have been fully considered but they are not persuasive. Applicant argues in the Remarks that Wang does not make reference to the use of those scissors to remove a cast from the patient.

In response to applicant's argument as mentioned above, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It should be noted that a protection member taught by Wang is fully capable of being adapted so that it can safely and operationally being held between the skin of the patient and the cast material during cutting process.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BHARAT C. PATEL whose telephone number is (571)270-3078. The examiner can normally be reached on Monday-Friday, alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 24502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bharat C Patel/  
Examiner, Art Unit 3724  
January 5, 2009.

/Ghassem Alie/  
Primary Examiner, Art Unit 3724